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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,351	09/28/2001	Franciscus Petrus Maria Mercx	120406-1	3890

7590 09/05/2003  
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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A 2/4

**Advisory Action**

Application N .

09/966,351

Applicant(s)

MERCX ET AL.

Examiner

Kevin R Kruer

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
 2. ☐ The proposed amendment(s) will not be entered because:  
 (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ they raise the issue of new matter (see Note below);  
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1,3,4 and 6-11.

Claim(s) withdrawn from consideration: 12.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
 9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11.  
 10. ☐ Other: \_\_\_\_\_

### **ADVISORY ACTION**

Applicant's arguments filed July 15, 2003 have been fully considered but they are not persuasive. For the purposes of appeal, the amendment will be entered.

Applicant has requested clarification of the 35 USC 112, second paragraph rejection. The examiner erroneously referenced claim 2 (canceled) in the rejection. However, the rejection is maintained for the reasons of record. Specifically, the term "non-blooming" is indefinite because there is no description in the specification on how one of ordinary skill in the art would determine whether a lubricant was non-blooming. Furthermore, the term "non-blooming" does not have an art accepted definition.

With respect to the rejection based upon Breitenfellner in view of Cohen, Applicant argues that Breitenfellner does not teach the claimed composition. The examiner agrees, but points out that Breitenfellner was never relied upon for such a teaching. Rather, Cohen teaches the claimed composition.

Applicant further argues that there is no support for the examiner contention that higher molecular weight release agents/lubricants exhibit less blooming than a lower molecular weight lubricant. In support of this statement, the examiner points to the disclosure of US 4,283,314 which states "...because of (the lubricant's) high molecular weight they have a relatively low volatility and little tendency to migrate so that the lubricant will less readily exude from the polymer phase (col 4, lines 38+)." Thus, the examiner maintains that applicant's results are not unexpected with respect to the "blooming" of the claimed lubricant.

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Applicant further argues that there is no teaching in Cohen that blooming was a matter of concern. However, the courts have held that the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Since Cohen teaches the same composition, the examiner maintains the position that it will necessarily exhibit the same properties.

With respect to the other rejections, Applicant states that the "same defect as discussed" with respect to Breitenfeller in view of Cohen apply. Thus, the rejections are maintained for the reasons of record.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700